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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/323,715	06/01/1999	GORDON COTTER CUNNINGHAM	BL01134-009B	9551

8698 7590 10/31/2005  
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EXAMINER

HARBECK, TIMOTHY M

ART UNIT PAPER NUMBER

3628

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/323,715

Applicant(s)

CUNNINGHAM, GORDON  
COTTER

Examiner

Timothy M. Harbeck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 08 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris (6,105,007) (note is a continuation of application 08/327,653 originally filed in 10/24/1994 J in view of Anonymous, "New sites on the World Wide Web Management Accounting." Montvale: Dec 1995.Vol. 77, Iss. 6., pg. 55, 1 pgs. (here after Reference E) and Times - "METAIRIE BANK JOINS INTERNET; [THIRD Edition] "Picayune (pre-1997 Fulltext)." New Orleans, La.: Sep 13, 1995. pg. C.1 (here after Reference B)

**With regard to claim 1** Norris teaches an electronic method for applying for a financial card (SEE Norris Column 1, lines 14-20 "The present invention relates generally to closed loop financial transactions. More specifically, the present invention is a method and apparatus for processing financial transactions automatically, including loans, applications for credit, establishment of accounts and other transactions that typically take place at banks. " and SEE Column 2, lines 53-58, " In the primary examples presented in the present invention, for loans and credit cards, the apparatus uses a computer controller and a telecommunications link, plus other electronic

communications equipment, to enable the complete, automated processing of the application"),

comprising: (a) storing in at least one data base (Ref 60) financial card data for participating financial institution, (b) providing ratings associated with said financial card data, (c) prompting an applicant for application data for use in assigning a rating to said applicant to locate financial card offers for said applicant, (d) analyzing said application data provided by said applicant, (e) assigning a rating to aid applicant based on said analyzing of said application data (SEE Norris column 2, lines 57-63, "(1) the exchange of information with the "touch-screen" or voice recognition technology, (2) the applicant, preferably using underwriting, which means the evaluation and, importantly, approval of the application" . . . "(4) completing of consumer financing regulatory requirements" and SEE column 3, lines 27-35, 'In a preferred embodiment, the computer capability of the present invention also contains evaluation criteria in the form of underwriting models, that are used to "score" the application; that is, to make a determination of whether to approve the application based on a computer analysis of factors deemed important in assessing the would be borrower's ability and willingness to repay the loan and to quantify the risk of its not being paid,")

Norris does not directly illustrate, "(f) Locating financial card offers for said applicant comparing said rating of said applicant with said financial card data for said participating financial institution, and (g) presenting to said applicant for review said financial card offers located for said applicant by comparing said rating of said applicant with said financial card data for said participating financial institutions." (Norris instead

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illustrates the basic concept with the example of just one Bank however it is well known in the prior art to duplicated a concept in order to have a "multiplicative effect" and to have done so would have merely been obvious to one of ordinary skill in the art at the time of invention and merely directed towards an "obvious intended use" of the Norris invention. Reference E teaches; " Credit Card Network, credit.com Offers a selection of online credit card application. Free lists of low interest, secured, rebate, frequent flyer, etc.." Reference B Teaches; This year 20 banks - with a combined market share of 21 percent - have set up Web sites to promote credit card products, said a RAM Research survey of 350 bank credit card issuers on use of the Internet for marketing bank credit cards. Another 29 percent of card issuers surveyed said they would launch a Web site in the next 12 months. Nearly half said they planned to include online credit card applications.")

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Norris invention to offer multiple card from multiple institutions because to do so would have been merely directed towards, "duplication of a well known procedure" and in any case Reference E and Reference B clearly illustrate multiple card offers from multiple financial institutions and still further "one stop comparative shopping" at one web site as illustrated by Reference E is very popular and much more efficient than having to log in to multiple web sites to do your shopping for a credit card.

**With regard to claim 2** the combination of Norris / Reference B / Reference E teaches a method of claim 1 further comprising sending said applicant a financial card

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in accordance with an accepted financial card offer (it would have been obvious after approval to mail the applicant a card because most places require the actual card and some times drivers license to use, so therefore sending the card would have been essential to optimum usage).

**With regard to claim 3** the combination of Norris / Reference B / Reference E teaches a method of claim 1 wherein said rating is a financial risk rating (SEE Norris column 3, lines 27-35, "preferred embodiment, the computer capability of the present invention also contains evaluation criteria in the form of underwriting models, that used to "score" the application; that is, to make determination of whether to approve the application based on a computer analysis of factors deemed important in assessing the would-be borrower's ability and willingness to repay the loan and to quantify the risk of its not being paid.")

**With regard to claim 4** the combination of Norris / Reference B / Reference E teaches a method of claim 1 wherein said participating financial institutions may modify said financial card data (SEE Norris column 3, lines 20-26 information about the applicant is also obtained via electronic transfer of data to the computer from one or more database, including those that provide name and address based on a caller's telephone number, and from credit bureaus that provide credit reports on an applicant given an applicant's name, a social security number and an address. Wherein since a card users address and telephone number are subject to change it is obvious that it is essential to have the capability to modify the database so they can send the bill to the right location.)

**With regard to claim 5** the combination of Norris / Reference B / Reference E teaches the method of claim 4 further comprising the step of uploading said modified financial card data (SEE Norris column 3, lines 20- 26 information about the applicant is also obtained via electronic transfer of data to the computer from one or more databases, including those that provide name and address based on a caller's telephone number, and from credit bureaus that provide credit reports on an applicant given an applicant's name, a social security number and an address. Wherein since any change in data such as address or telephone would need to be entered at a computer terminal which uploads the data from the keyboard to the internet any again it is essential to have the capability to modify the database so they can send the bill to the right location an uploads are a common way of doing this).

**With regard to claim 6** the combination of Norris / Reference B / Reference E was shown above in claims 1-5 to read on most of the limitations of claim 6 in addition the combination teaches, (a) creating a public network site, said site associated within identifier for accessing said site (See Norris illustrates an ATM machine in figure 2 it would have been obvious to locate it in a public site to facilitate good sales and further it is a well known practice to use a code password when using a card at an ATM so this therefore reads on "identifier"), (b) defining terms for financial cards (c) associating ratings with said financial card terms (See Norris column 6, lines 45-64 "The applicants credit report is obtained from the credit bureau by transaction processor 10, evaluated using an underwriting model 90, to be described more fully below, and a decision is made based on the results of the evaluation by underwriting model 90, which results are

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in the form of an associated risk factor, to grant or deny the loan or credit card application. Transaction processor 10 informs the borrower of the decision and, if the application is granted, presents the terms of the financial transaction to the applicant via monitor 50. If the borrower accepts the terms of the loan or credit card, the borrower can sign the documents electronically using an electronic signature pad 100 on kiosk. The same approach can be used to verify in writing the fact that the borrower understood the terms of the loan or credit card, as required by law, or, if the loan or credit card is denied, that the borrower received a copy of the negative determination letter with its explanation as to why the application was denied. In each case the consumer's signature on the documentation can be secured electronically").

Furthermore as was the case with claim 1, Norris illustrates the basic concept with the example of just one Bank however it is well known in the prior art to duplicated a concept in order to have a "multiplicative effect" and to have done so would have merely been obvious to one of ordinary skill in the art at the time of invention and merely directed towards an "obvious intended use" of the Norris invention. Reference E teaches; " Credit Card Network, credit.com Offers a selection of online credit card application. Free lists of low interest, secured, rebate, frequent flyer, etc.." Reference B Teaches; This year 20 banks - with a combined market share of 21 percent - have set up Web sites to promote credit card products, said a RAM Research survey of 350 bank credit card issuers on use of the Internet for marketing bank credit cards. Another 29 percent of card issuers surveyed said they would launch a Web site in the next 12 months. Nearly half said they planned to include online credit card applications.")



Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Norris invention to offer multiple card from multiple institutions because to do so would have been merely directed towards, "duplication of a well known procedure" and in any case Reference E and Reference B clearly illustrate multiple card offers from multiple financial institutions and still further "one stop comparative shopping" at one web site as illustrated by Reference E is very popular and much more efficient than having to log in to multiple web sites to do your shopping for a credit card.

**With regard to claim 7** the combination of Norris / Reference B / Reference E teaches the method of claim 6 further comprising sending information regarding said applicant to a participating financial institution sponsoring said offer accepted by said applicant (Reference E it is obvious that the information will be forwarded to the bank by third party because it would be essential in completing the sale).

**With regard to claim 8** the combination of Norris / Reference B / Reference E teaches the method of claim 6 further comprising sending to said applicant a financial card in accordance with an offer accepted by said applicant (this feature was addressed above in claim 2).

**With regard to claim 25** the combination of Norris / Reference B / Reference E teaches the method of claim 6 wherein said electronic financial card is selected from the group consisting of credit cards and debit cards (the combination clearly show credit cards and a debit card is just a well known type of credit card that takes the money quickly from your account).

**With regard to claim 9** the combination of Norris / Reference B / Reference E was shown above in claims 1-8 to read on most of the limitations of claim 9 in addition the combination teaches, at least one server for communicating with a financial card applicant (SEE Norris figure 1 and 2 wherein it does not directly illustrate a server such a server would have been essential for the kiosk to access the network so is therefore a clearly obvious feature), at least one device adapted to access data from third party sources, (SEE Norris figure 1 item 60 DATABASE CREDIT BUREAU).

Claims 10-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Norris / Reference B / Reference E in further view of Lockwood (6,289,319)

**With regard to claim 10** the combination of Norris / Reference B / Reference E was shown above in claims 1-9 and 25 to read on most of the limitations of claim 10. However, the above combination does not clearly illustrate the "a first database for storing financial institution data comprising financial institution selection criteria and financial offering data for participating financial institutions, a second database for storing credit history data; and one or more servers adapted."

Lockwood clearly teaches these additional above features (See Lockwood figure 1 and abstract: "A system for filing applications with an institution from a plurality of remote sites and for automatically processing said applications in response to each applicants credit rating obtained from a credit reporting service headquarters. Each remote terminal comprises a video screen and a video memory which holds image and

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sound generating information arranged to simulate the aspect and speech of an application loan officer on the video screen. The simulated loan officer is used to acquire loan request data from the applicant by guiding him through an interactive sequence of inquiries and answers. The terminal is programmed to acquire credit rating data relating to the applicant from the credit rating service, and to use the data to compute the credit worthiness of the applicant and the amount which may be loaned to him. The approved loan information is then transmitted to the first computer for further processing by the financial institution. "SEE Column 4, lines 54-60) "Once all the proper answers have been accepted, they are processed 46 by the terminal data processor 13. This process may involve analyzing certain key answers in order to identify any element or data that would automatically disqualify the applicant. Depending upon the result of that first analysis, more questions 47 may be presented to the applicant in order to refine the data necessary for a through assessment of his qualifications." SEE column 5, lines 53-67. It should be noted that the system as described could be applied to other forms of transactions in which information has to be acquired from a customer then processed to a decision or into the performance of a particular task. A similar system could be used, for instance, for the preparation and filing of income tax returns. In such case, the assistance that the fictitious person who appears on the video screen can give to the applicant in filling out the tax form can be easily programmed on the videodisc. Other applications of the system include the selection and purchase of stocks and other securities, the selection and opening of so-called "self-directed investments" such as Individual Retirement Accounts, and other complex transactions

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which normally require a great deal of time and attention on the part of the officers of an institution.").

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify or interpret the combination of Norris / Reference B / Reference E to implement the above features related to selection criteria as taught by Lockwood because to do so would have been an improvement in making sure the customer gets the best product and the bank gets the proper level of risk so they can make more money.

**With regard to claim 11** the combination of Norris / Reference B / Reference E / Lockwood teaches the system of claim 10 wherein said application data comprises the applicant's name, telephone number, home address, e-mail address; income, other assets and liabilities, and bank account numbers (This information was representative of well known information required on loan and credit card applications and therefore made obvious and directed towards the "obvious intended use" of the combinations credit applications).

**With regard to claim 12** the combination of Norris / Reference B / Reference E / Lockwood teaches the system of claim 10 wherein said appropriate financial offerings for said applicant are located in accordance with a grading system process ( this feature was illustrated already above.)

**With regard to claim 13** combination of Norris / Reference B / Reference E / Lockwood teaches the system of claim 12 wherein said grading system process assigns a grade/score to the applicant using the application data and credit history data and

uses the grade/score to search each participating financial institution's selection criteria to locate the appropriate financial offerings (this feature was illustrated already above).

**With regard to claim 14** the combination of Norris / Reference B / Reference E / Lockwood teaches the system of claim 13 wherein each financial institution's selection criteria are organized in a matrix associating financial offering data with a minimum grade/score combination (the combination does not directly illustrate the common practice of arranging choices in a matrix but examiner serves "OFFICIAL NOTICE" that this feature is well known in the prior art and one would be motivated to do this to facilitate visual information to the user in a clear way)

**With regard to claim 15** the combination of Norris / Reference B / Reference E / Lockwood teaches the system of claim 10 wherein each of said appropriate financial offerings is presented to the applicant in a single computer display (SEE Norris figure 2, item 50).

**With regard to claim 16** the combination of Norris / Reference B / Reference E / Lockwood teaches the system of claim 10 wherein said appropriate financial offerings are presented in the form of a menu comprising a summary of each financial offering from which the applicant may make a selection to review details of the financial offering

(SEE Norris figure 2 item 50 a monitor with touch screen capability Touch screen capability in monitors is well known. SEE column 5, line 43-57 'To indicate a choice presented by a computer monitor having touch screen capability, the user simply touches the screen at the location indicated. For example, images of a "yes" and a "no"

button will appear and, by touching the "yes" button, the consumer indicates an affirmative answer to the question presented". )

**With regard to claim 17** the combination of Norris / Reference B / Reference E / Lockwood teaches the system of claim 10 wherein said financial offerings are credit card offerings (SEE Norris figure 1 CREDIT/DEBIT CARD).

**With regard to method claims 18-24** the combination of Norris / Reference B / Reference E / Lockwood was shown above in claims 1-17 and 25 to read on all the claimed features.

### ***Response to Arguments***

Applicant's arguments filed 8/18/2005 have been fully considered but they are not persuasive. Applicant has argued that the only features not taught by the Norris / Reference B / Reference E combination involve the selection and locating of financial offers on behalf of a credit applicant. The majority of the amendments issued to the claims deal with this assertion, however, as was stated in the previous office action, Reference E shows a website that "offers a selection of online credit card applications." This offering of multiple selections indicates that the financial offers have already been located by this particular website. Furthermore, the examiner had provided the motivation for a combination of the above references in that modifying the Norris invention to offer multiple cards (selections) from multiple financial institutions is directed towards a duplication of a well known procedure and that both References E and Reference B illustrate the availability of multiple offerings from multiple financial institutions. It has also previously been stated that it was well known to provide a "one

stop comparative shopping" at one web site as illustrated by Reference E, as this is popular and much more efficient than having to access multiple websites individually for the purpose of receiving different options.

Furthermore, examiner believes that he has made a prima facie case of obviousness with regards to the combination of references. Applicant, while amending the claims has offered no arguments refuting the motivation one skilled in the ordinary art would have in combining the references. The arguments provided by the applicant simply state that none of the references show "selecting or locating financial offers on behalf of a credit applicant." However, the examiner believes and has provided evidence and arguments to the contrary. Since no arguments were made concerning the examiners prima facie case of obviousness, it is sustained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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